

REMARKS/ARGUMENTS

These remarks are responsive to the Office Action dated February 6, 2004. Currently, Claims 1-45 are pending with Claims 1, 8 and 24 being independent. Claims 1, 8 and 24 have been amended. Support for these amendments can be found on page 4, lines 17-18 and throughout the specification.

The Examiner rejected Claims 1-10, 12-19, 21-31, 33-41 and 44-45 under 35 U.S.C. 102(b) as being unpatentable over US Patent No. 5,732,216 Logan et al. ("Logan").

The Examiner rejected Claims 11, 20, 32, 42 and 43 under 35 U.S.C. 103(a) as being unpatentable over Logan in view of US Patent No. 6,085,231 Agraharam et al. ("Agraharam").

These rejections are respectfully traversed for at least the reasons set forth below.

35 U.S.C. 102(b)

The Examiner rejected Claims 1-10, 12-19, 21-31, 33-41 and 44-45 under 35 U.S.C. 102(b) as being unpatentable over Logan. These rejections are respectfully traversed.

Claim 1 of the present invention recites an electronic message comprising a sound file and a predetermined identifier indicating an aspect of the sound file. As disclosed in the detailed description, indicating an aspect refers to noting if a correct feature is present and enabled in the identifier, and if it is enabled, automatically opening and playing the sound file (*See* Page 4, lines 17-18). This is not disclosed by the references cited by the Examiner. However, in an effort to more clearly claim the invention, applicant has amended Claim 1 to include what is meant by indicating an aspect of the sound file. The predetermined identifier indicates a course of action to be taken with the sound file (i.e. whether to automatically play the sound file or not).

Logan describes an audio program distribution system in which a host system organizes and transmits program segments to client subscriber locations. Program segments are associated with descriptive subject matter segments, and the subject matter segments may be used to generate both text and audio cataloging presentations to enable the user to more easily identify and select desirable programming. (*See Abstract*)

In contrast to the present invention, the identifier in Logan is used to mark a location within a program segment and does not identify how to treat the program segment. For example, Logan uses an identifier to bookmark a program segment so that it can be later retrieved from storage. "By bookmarking a program segment, that segment may be recalled by the subscriber and all or part of it saved for later use in local storage, from which it may be reproduced, forwarded as an attachment to an email message, and the like." (*See Col. 15, lines 15-19*) Logan also uses an identifier to tag the beginning and ending of the audio file. "These tags are translated into the "H" and "E" recorded pairs in the selections file which identify the beginning and ending of the phrase in the audio file." (*See Col. 44, lines 12-15*) In addition, Logan uses an identifier to indicate a position in the recording. "[I]dentification data includes the specification of a chosen position in said selected audio recording to which said audio annotation relates" (*See Col. 45, lines 52-54*) In all of the examples presented above, Logan discloses an identifier to mark something in the sound file. In contrast to the present invention, Logan does not disclose a predetermined identifier used to indicate an action to perform on the sound file (i.e. indicating an aspect of the sound file).

Logan does not disclose all of the elements of Claim 1 of the present invention and the rejection is respectfully traversed. The Examiner is respectfully requested to reconsider and withdraw his rejection of Claim 1. Claims 8 and 24 were rejected for the same reasons as Claim

1. Claims 8 and 24 were amended to correspond with the amended Claim 1. The rejections of Claims 8 and 24 are respectfully traversed for at least the same reasons as with respect to Claim 1. The Examiner is respectfully requested to reconsider and withdraw his rejections of Claims 8 and 24.

Claims 2-7; 9-10, 12-19, 21-23; and 25-31, 33-41 and 44-45 depend on independent Claims 1, 8 and 24 respectively. The rejection of Claims 2-7; 9-10, 12-19, 21-23; and 25-31, 33-41 and 44-45 is respectfully traversed for at least the same reasons with respect to Claims 1, 8 and 24. The Examiner is respectfully requested to reconsider and withdraw his rejection of Claims 2-7, 9-10, 12-19, 21-23, 25-31, 33-41 and 44-45.

35 U.S.C. 103(a)

The Examiner rejected Claims 11, 20, 32, 42 and 43 under 35 U.S.C. 103(a) as being unpatentable over Logan in view of Agraharam. These rejections are respectfully traversed.

The deficiencies of Logan were pointed out above. Agraharam also fails to disclose a predetermined identifier indicating an action to perform on the sound file and hence fails to cure the deficiencies of Logan. Since neither Logan, Agraharam nor the combination thereof teaches or suggest the presently claimed invention, Claims 1, 8 and 24 are novel over the combination of Logan and Agraharam. Claims 11 and 20; and 32, 42 and 43 depend from Claims 8 and 24 respectively. The Examiner is respectfully requested to reconsider and withdraw his rejections of Claims 11, 20, 32, 42 and 43.

Improper to Combine References:

The Examiner asserts that it would have been obvious to combine Logan in view of Agraharam so as to arrive at the present invention. However, there is no suggestion or

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motivation to combine the teachings of Logan and Agraharam. Logan is directed to an audio program and message distribution system in which a host system organizes and transmits program segments to client subscriber locations. Agraharam is directed to a system where a subscriber to alias telephone number e-mail system can retrieve both their voice-mail messages and e-mail messages by accessing only their e-mail system. Thus, one skilled in the art, facing the problems that the Applicants faced would not combine these references as the Examiner suggests.

The Applicants respectfully point out to the Examiner, that the burden of proof lies with the Examiner to show such a teaching or suggestion to combine the references, other than in the present application. This is required as a matter of law:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that created the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art referenced for combination in the manner claimed. *In re Rouffet*, 149 F. 3d 1350, 1357 (Fed. Cir. 1998). *See also, In re Dembiczak*, 175 F. 3d 994, 99 (Fed. Cir. 1999) ('Combining prior art references without evidence of such a suggestion, teaching or motivation [to do so] simply takes the inventor's disclosure as blueprint for piecing together the prior art to defeat patentability - the essence of [impermissible] hindsight.').

The Examiner in the present case has not proffered a motivation in the reference or otherwise to combine Logan and Agraharam. The Examiner has not shown why someone faced with the same problems as the Applicants would combine Logan and Agraharam to arrive at the present invention.

The combination of Logan and Agraharam does not support a case of obviousness as suggested by the Examiner and the rejection is respectfully traversed. The Examiner is respectfully requested to reconsider and withdraw his rejection of Claims 11, 20, 32, 42 and 43.

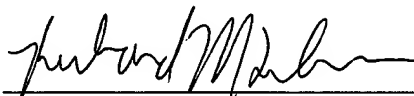
Other Matter

No new matter has been added.

The claims currently presented are proper and definite. Allowance is accordingly in order and respectfully requested. However, should the Examiner deem that further clarification of the record is in order, we invite a telephone call to the Applicants' undersigned attorney to expedite further processing of the application to allowance.

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Respectfully submitted,



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